

REMARKS

Reconsideration and withdrawal of the objections and rejections to the application are requested in view of the amendments and remarks presented herein, which place the application into condition for allowance, or at least into better condition for appeal.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1 and 3-16 are pending in this application. Claims 1, 15 and 16 are amended according to suggestions made by Examiner Sullivan during a telephone conference on or about July 19, 2004. Support for the amendments can be found throughout the specification. Specific support for the hybridization conditions recited in claim 1 can be found beginning on page 15, line 26. Support for the claimed percent identity can be found in canceled claim 18. No new matter is added.

It is submitted that these claims are patentably distinct from the prior art, and that these claims are and were in full compliance with the requirements of 35 U.S.C. §112. The amendments of the claims herein are not made for the purpose of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112; but rather, the amendments are made simply for clarification and to round out the scope of protection to which Applicants are entitled. Furthermore, it is explicitly stated that the herewith amendments should not give rise to any estoppel, as the herewith amendments are not narrowing amendments.

II. THE REJECTION UNDER 35 U.S.C. §112, 1ST PARAGRAPH, IS OVERCOME

Claims 1 and 3-16 were rejected under 35 U.S.C. §112, first paragraph, as allegedly lacking adequate written description. The rejection is traversed.

The Office Action notes that part a) of claim 1 is directed to a nucleic acid molecule comprising Seq ID No. 1. The Examiner is thanked for helpfully indicating during a telephone conference on or about July 19, 2004 what embodiments of the invention he considers to be adequately described; claim 1 has been amended accordingly. Specifically, the Advisory Action objected to the previously presented version of claim 1 because parts d) and e) recited hybridization and percent identity to a nucleic acid molecule selected from any of Seq ID Nos. 1-8. The claims have been amended, such that they now recite hybridization and percent identity to Seq. ID No. 1.

The Examiner's attention is directed to Example 9 of the U.S.P.T.O.'s "Synopsis of Application of Written Description Guidelines". The fact pattern presented in Example 9 is

analogous to the current situation: a DNA sequence has been identified and specific hybridization conditions are stated. The following elements are required by Example 9: 1) hybridization techniques using a known DNA sequence as a probe, under the recited conditions, were conventional in the art at the time of filing; 2) the claim is drawn to a genus of nucleic acids, all of which must hybridize with the disclosed species (in this case, Seq, ID No. 1) and must be or encode a molecule with a specific activity (*i.e.* the function of a caryopsis-specific promoter); 3) the claimed species, Seq, ID No. 1, is novel and unobvious; 4) the single species disclosed, Seq, ID No. 1, is within the scope of the claimed genus; 5) there is actual reduction to practice of the disclosed species. The instant claims and application meet all of these requirements; therefore, written description is present.

The Examiner's attention is further directed to Example 14 of the USPTO's "Synopsis of Application of Written Description Guidelines", in relation to claiming variants of a disclosed molecule. The claim in Example 14 recites the structure of the claimed protein, in the form of a SEQ ID NO and variants with a particular percent identity to the recited sequence, and function in the form of identifying the reaction that the molecule catalyzes. Claim 1 of the instant application recites (1) structure of the claimed molecule in the form of a SEQ ID NO and variants with 95-99% identity to the recited sequence, and (2) function of the claimed molecule in the form of its caryopsis-specific promoting activity. As discussed in Example 14, even if the claimed SEQ ID NO is the only species disclosed, it is representative of the genus because all members of the genus have the claimed level of identity with and function of the protein described by the reference sequence. Therefore, according to Example 14 of the Written Description Guidelines, claim 1, as presented herein, meets the written description requirement of 35 U.S.C. §112, first paragraph.

Reconsideration and withdrawal of the rejection under 35 U.S.C. §112, first paragraph, is requested.

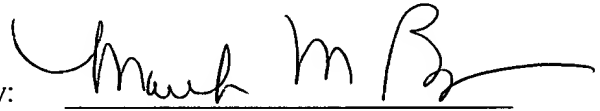
CONCLUSION

Applicants believe that the application is in condition for allowance, and favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The Examiner is invited to contact the Applicants' representative if there are issues that could be resolved telephonically, leading to allowance of the application. Alternatively, consideration and entry of this paper is requested, as it places this application into better condition for purposes of appeal.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicants

By:



Marilyn Matthes Brogan
Registration No. 31,223

Anne-Marie C. Yvon, Ph.D.
Registration No. 52,390
(212) 588-0800